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NOTICE OF ALLOWANCE AND FEE(S) DUE

7590

03/18/2010

Martin D. Moynihan
PRTSI, Inc.
P. O. Box 16446
Arlington, VA 22215

EXAMINER

NGUYEN, NGO A B

ART UNIT

PAPER NUMBER

3684

DATE MAILED: 03/18/2010

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/069,234 | 02/22/2002 | David Konopnicki | 02/23229 | 1417 |

TITLE OF INVENTION: SYSTEM AND METHOD FOR AUTOMATED CONTRACT FORMATION

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE DUE | PUBLICATION FEE DUE | PREV. PAID ISSUE FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|---------------|---------------------|----------------------|------------------|------------|
| nonprovisional | YES | \$755 | \$0 | \$0 | \$755 | 06/18/2010 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
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or Fax **(571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

7590 03/18/2010

Martin D. Moynihan
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Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

| |
|--------------------|
| (Depositor's name) |
| (Signature) |
| (Date) |

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| nonprovisional | YES | \$755 | \$0 | \$0 | \$755 | 06/18/2010 |

| EXAMINER | ART UNIT | CLASS-SUBCLASS |
|---------------|----------|----------------|
| NGUYEN, NGA B | 3684 | 705-037000 |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY AND STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____
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This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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EXAMINER

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Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 1458 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 1458 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Notice of Allowability**Application No.**

10/069,234

Applicant(s)

KONOPNICKI ET AL.

Examiner

Nga B. Nguyen

Art Unit

3684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment filed on December 22, 2009.
2. ☒ The allowed claim(s) is/are 1-42.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on December 22, 2009, which paper has been placed of record in the file.
2. Claims **1-42** are pending in this application.

Allowable Subject Matter/Reasons for Allowance

3. Claims **1, 30, 38, 40, and 42** are allowed over the prior arts cited records.

The closest prior arts are:

1) Kennedy (US 6,055,519) discloses negotiation process which is operated *by the users themselves*. Kennedy provides the user with *information* which could be *helpful for planning and tracking the negotiation* but does *not* relate to the user's intentions, objectives and desires *or* generate requests itself. The data processor in Kennedy *does not generate intentions*. The requests or promises are generated *by the users* and Kennedy's system merely *receives and passes on* the already generated request. Furthermore, the data processor in Kennedy *could not generate* an intention according to a reference to a value since Kennedy's system *is not aware* of the *desires and objectives* of the seller or buyer but rather relates to the specific request only. As described for example in col. 9, lines 45-56, Kennedy's system merely adds a bureaucratic flag to a request indicating if an agreement was reached or not. This is as *far as Kennedy goes* with respect to relating to the contents of the requests. There is no hint in Kennedy for referring to the intentions of the users which formalize their objectives and generating a request accordingly. Likewise stages e) and f) define

method steps of comparing the two intentions and determining the relationship if they coincide - *that is, there is a deal that is consistent with the specifications of all parties.*

Thus Kennedy *fails* to teach that the intentions are *generated* at the user modules and a *central server* that forms a *common intention* from the *generated* user intentions. In Kennedy, the seller system is equivalent to a central server because the negotiation is stated to be without an intermediary, so that while the seller system in Kennedy comprises of a negotiation engine, it is aware only of the intentions of the seller and does not have any knowledge of the buyer's intentions, except for the explicit and fully formed requests received from the buyer. Accordingly, the seller system in Kennedy cannot generate a common user intention by *merging of said respective user party intentions*. Thus neither the seller client nor the buyer client in Kennedy ever forms the unified intent from *generated* intentions of the party. Irrespective of whether there is an intermediary, Kennedy fails to teach anyone providing a unified intention from the generated party intentions. Moreover, Kennedy merely *receives* intentions from the users. Kennedy does not teach a *device* which *adds* components to the intention. On the contrary, in Kennedy there are only the original components, and all these are added by the users. Features can be changed, as Monday is changed to Wednesday, but there is no *adding* of features when intentions are not matched. Thus Monday cannot be changed to Monday and Tuesday, and indeed this would clearly make no sense. Kennedy's system *receives* the *altered* request and does not *generate an additional* component since in Kennedy the system is aware of the explicit request as

issued only and does not have any knowledge of the user's intentions which are not define in the initial (explicit) request.

Furthermore, Kennedy does not mention the concept of normalization. Lack of normalization is significant. Without such normalization he *cannot* minimize quantities that are not measured in the same units, such as combinations of dates and locations. He cannot even minimize just locations by themselves as locations are non-numeric. That is to say not only does he not *teach* minimization, without normalization he *cannot* perform minimization. Thus Kennedy does not teach normalization and minimization. Moreover, Kennedy at no point relates to multiple *levels* of decision making, At the most he allows one to *queue* a first request while dealing with a second request. There is no indication in the passages quoted of a hierarchy of requests or considerations. Kennedy does not relate to creating a *minimizing* goal for a level within a goal program. Kennedy is concerned with managing the negotiating process and does not take part in the actual negotiation process itself and especially not in forming offers and counter offers. Accordingly, Kennedy does not create a minimizing goal. Kennedy teaches *"Promising policy" specifies the constraints on offering a Promise for the corresponding Request. The following describes the available promising policies:*" Thus, Kennedy indeed has constraints. The constraints of Kennedy can be chosen as one of a given group of constraints. However the present claim defines that constraints are provided at different levels in a goal program, and at each level the different constraints are minimized. In addition, Kennedy does not teach *combining normalized constraints for creating a minimized goal for a level.* This is

because the constraints *are not organized in levels*, and furthermore the constraints are not numerical and the non-numerical constraints of Kennedy thus cannot be minimized.

2) Ferstenberg (US 6,968,318) discloses a central exchange, such as NASDAQ, where participants exchange *commodities* via an electronic intermediary. In Ferstenberg, a direct relationship allowing complex interaction, whether a relationship of trading or of negotiation, between individual participants, is not set up, but rather the electronic intermediary obtains a quantity of items from a totality of sellers and attempts to allocate the commodities amongst a totality of buyers while meeting various market targets. See column 37 lines 6 - 10 where *e-agent* offers are counted by *intermediary* counter offers. In contrast, the present invention concerns negotiations between two parties where the parties positions are expressed via intentions, and do not necessarily involve commodities. In the present claims, it is user parties and not an intermediary who take part in negotiation steps, and that direct negotiations are carried out between user parties to arrive at a common user intention, which is made up of the unification of two or more individual user intentions. A common user intention is not taught in Ferstenberg.

Therefore, it is clear from the description of Kennedy's and Ferstenberg's inventions that the prior arts do not considered the possibility of: *electronically generating a merged portion, said merged portion also being within said intention data structure, said generating a merged portion being according to said reference to said value in said at least one dispatch, said electronically generating comprising within a respective data processor merging at least a portion of said first user intention and at*

least a portion of said second user intention, said portions comprising the said at least one of said respective components to which said value refers, as included in claim 1; a central server connected to said plurality of computers over said network, the central server being a computer, the central server being configured for at least initially connecting at least said first user party module to at least said second user party module for performing said direct negotiations to reach said agreed value, said negotiating comprising generating within said system a common user intention according to said intention data structure by merging of said respective user party intentions, as included in claim 30; when said first intention matches said second intention, then electronically merging the respective first and second intentions to form a common user intention, and determining the relationship according to said common user intention, said common user intention also being in accordance with said intention data structure, as included in claim 38; said processor comprising a unifier, associated with said negotiation control program configured to unify said user intentions via said intention data structure of said memory, said unifier being implemented within said processor via said process of negotiation between users, said negotiation being via said user interface to form a merged user intention, said merged user intention also being within said data structure, said merged user intention unifying said respective first and second intentions, therefrom to define the relationship in accordance with said data structure, as included in claim 40; electronically normalizing each of said identified constraints respectively to render said identified constraints mutually comparable, so as to obtain normalized constraints at said electronic computers and electronically

combining said normalized and thus mutually comparable constraints to create said minimized goal for said level at said electronic computers thereby to provide a level within said hierarchy having a minimized goal and thus providing levelwise solution of said goal program, as included in claim 42.

4. Claims (2-29), (31-37), 39 and 41 are allowed because they are dependent claims of the allowable independent claims 1, 30, 38 and 40 above, in that order.

Conclusion

5. Claims **1-42** are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Friday from 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria VA, 22131-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label
"PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3684

March 10, 2010.